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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,960	05/29/2001	Neil D. Scancarella	Rev 01-6	7403

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EXAMINER

OSTRUP, CLINTON T

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/866,960	Applicant(s) SCANCARELLA ET AL.	
	Examiner Clinton Ostrup	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/17/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 23-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-21 and 23-87 are pending in this application.

Response to Applicant's Arguments/Amendment

Claim Rejections - 35 USC § 112

Applicant's amendment filed October 14, 2003, has made the rejection of claims 1-21 and 23-85, and 87 under 35 U.S.C. 112, Second Paragraph, moot. Therefore, the said rejection has been withdrawn.

Claim Rejections - 35 USC § 103(a)

Applicant's amendment and arguments filed October 14, 2003, to the rejection of claims

1-21 and 23-87 as being rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw, WO 00/47168 and McDermott, **US 6,248,336 B1**, and further in view of Calello et al., 5,849,275 have been fully considered; however, they have not been found convincing. Therefore, the said rejection has been MAINTAINED.

Applicant argues that the none of the references relied upon in rejecting the pending claims disclose a cosmetic composition which includes the ingredients required by the presently mended claims where the composition has a viscosity of about 1,000 to 500,000 centipoises at 25 degrees Celsius and where the organic pigment is the main color component of the composition and is present in an amount of 0.1-95%. Applicant also argues that none of the cited references teach how the film forming polymers required for the claimed compositions are combined with organic pigments in order to

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provide a cosmetic composition having a viscosity of 1,000 to 500,000 centipoises at 25 degrees Celsius, as claimed.

It is the examiner's position that it is well within the skill of those having ordinary skill in the art, to adjust the viscosity of an emulsion to arrive at a desired viscosity. The examiner is providing Cosmetics, Science and Technology, Emulsification, Chapter 42, (1966) by William C. Griffin as a teaching reference to demonstrate that those skilled in the art clearly recognize the viscosity of an emulsion as a property of an emulsion which can easily be controlled. See: pages 998-1004.

Applicant further argues that McDermott fails to address the limitations of claims 30, 48, 66, 81, and the claims, which depend therefrom, where the claim limitations require the organic pigment and the inorganic pigment, if present, to either be solubilized in or dispersed in a particular phase of the composition.

In response to this argument, the examiner is providing a Cosmetics, Science and Technology, Color in Cosmetics, Chapter 44, (1966) by Samuel Zuckerman, as a teaching reference to demonstrate that those skilled in the art clearly recognize that the solubilization of the pigment depends upon the inherent solubility parameters of the pigment itself. However, as taught by Zuckerman, all of the FD&C colors are soluble either in water or in oil. Moreover, Zuckerman teaches that inorganic pigments are available to the cosmetic chemist as water-soluble dyes, oil-soluble dyes, and insoluble pigments. Thus, it is the examiner's position that one having ordinary skill in the art would readily recognize that hydrophobic ingredients are soluble in other hydrophobic

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ingredients and conversely, hydrophilic ingredients are soluble in other hydrophilic ingredients.

In response to Applicant's argument that it is there is nothing that would suggest or direct one of ordinary skill to combine the teachings of these "diverse" references in a manner which would reasonably lead to or result in the specific combination of ingredients in the form and amounts required, as claimed, the examiner respectfully disagrees. All of the references cited are drawn to cosmetic compositions and "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Shah teaches long wearing cosmetic compositions for topical application to the skin that do not run or settle in the lines and creases of the skin. The reference teaches that the cosmetic compositions are particularly useful as eyeliners, or

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other eye or skin products. The reference teaches combining a acrylic acid or methacrylic acid derived polymer or copolymer and water soluble organic pigments to unexpectedly create a water resistant, long lasting film forming composition which can be applied to the skin. The primary reference teaches the specific organic pigments as claimed instantly and describes how it **may** be desirable to include small amounts of additional pigments such as inorganic pigments or combinations of organic and inorganic pigments. Therefore, the reference teaches compositions which may or may not contain inorganic pigments as color imparting ingredients in their invention.

McDermott describes how the make-up compositions of the present invention contain cosmetically acceptable pigments selected from the group of inorganic pigments, organic pigments, and pearlescent pigments and that the pigments are present in proportions depending on the color and the intensity of the color which it is intended to produce. This suggests that the skilled artisan can easily and readily choose any desired pigments, including organic pigments with or without inorganic pigments, based on the color desired. Moreover, the reference clearly identifies organic pigment commonly used in cosmetic compositions.

Calello et al., teach glossy transfer resistant cosmetic compositions which can be incorporated into water and oil emulsions comprising a polymer, a volatile solvent, a nonvolatile oil, a dry particulate matter, and water. The reference teaches that compositions comprising the polymer are long lasting, have a high gloss and shine and do not easily transfer to clothing or utensils.

Response to Declaration

Applicant's request for the examiner to reconsider the Declaration of Jean Manelski under 37 CFR 1.132 filed April 23, 2003 (Paper No. 14) and the data presented in the declaration has been acknowledged. However, the declaration is still deemed insufficient to overcome the rejection of claims 1-21 and 23-87 because while it compares properties of the composition that are no longer being claimed and it appears, prima facie, that a combination of the references would result in the claimed properties of the composition.

Maintained Rejection

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-21 and 22-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah, WO 00/47168, and McDermott et al. 6,248,336, and further in view of Calello et al., 5,849,275.

Shah teaches long wearing cosmetic compositions for topical application to the skin that do not run or settle in the lines and creases of the skin. The Shaw reference teaches that the cosmetic compositions are particularly useful as eyeliners, or other eye or skin products. The Shaw reference teaches combining a acrylic acid or methacrylic acid derived polymer or copolymer and water soluble organic pigments to unexpectedly create a water resistant, long lasting film forming composition which can be applied to the skin. The Shaw reference teaches the specific organic pigments as claimed instantly

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and describes how it **may** be desirable to include small amounts of additional pigments such as inorganic pigments or combinations of organic and inorganic pigments.

Therefore, the Shaw reference teaches compositions which may or may not contain inorganic pigments as color imparting ingredients in their invention. Furthermore, the Example of a Longwearing Cosmetic Composition on page 6 does not contain inorganic pigments. Moreover, the reference does not teach waxes or organic gelling agents in the composition, therefore, meeting the negative limitations of claim 86-87. Shah teaches that the compositions of the invention include any aqueous base that is miscible in water and can include glycerin and hydroalcohols, such as ethanol, propanol, and glycols, thus meeting the plasticizer limitation of instant claims 25, 42, 44, 61, and 78 as well as the volatile components of instant claims 16-17, 36-37, 53-54, 71-72, and 84-85. See: page 2, line 22 – page 6, line 35.

Although the Shaw reference teaches long lasting organic pigmented, film forming cosmetic compositions, which may further contain inorganic pigments, the Shaw reference lacks the specific water and oil emulsions as claimed instantly in claims 1-21 and 23-87, the copolymers of instant claims 18-20, 38-40, 55-57, and 73-75, the surface coating of pigments as claimed in claims 33, and 50, and the pigments comprised in specific phases as claimed instantly in claims 3-4 and 30-85.

McDermott teaches cosmetic make-up compositions, particularly eye make-up compositions, such as mascaras, in the form of aqueous emulsions. The emulsions are taught to comprising insoluble polymeric material in an aqueous emulsion or latex and a lipophilic oil. These emulsions are then used to produce mascaras with improved wear

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and water resistance and are removable with soap and water. See: col. 1, lines 4-68 and abstract.

McDermott describes how polymeric emulsions containing plasticizers and solvents are well known in the art and that these compositions contain thickeners including water-soluble and water-swellaable polymers typically used in the art. See: col. 1, lines 26-40.

The McDermott reference describes how the compositions of their invention can be fabricated into a multitude of forms such as water-in-oil and oil-in water-emulsions to make creams and pastes. Thus meeting the limitations of instant claims 1-2, 30, 48, 66, 81, and 86. The McDermott reference teaches that the proportion of pigments used depends on the color and intensity of the color desired and that the pigments are selected from inorganic pigments, organic lake pigments, pearlescent pigments, and mixtures thereof. McDermott describes how the pigments may be surface-treated and teaches the specific inorganic and organic pigments of instant claims 5-8, 13, 31-33, 49-50, 67-68, and 82-83. See: col. 6, lines 1-45.

The McDermott reference teaches that optional ingredients such as silica, mica, talc, polymethacrylate, polyethylene, and thickeners such as water dispersible clays, which meet the specific limitations of instant claims 26-29, 45-47, 62-65, and 79-80. See: col. 6, line 45 – col. 7, line 10. McDermott exemplifies as an object of the invention to provide a mascara composition which comprises an alkyl or alkoxy-dimethicone copolyol as well as the insoluble polymeric material in an aqueous medium. See: col. 2, line 1 – col. 5, line 4.

McDermott teaches the use of polar oils and volatile oils, which meet the volatile components of instant claims 15-17, 36-37, 53-54, 71-72, and 84-85. However, McDermott lacks the teaching of the phases in which the emulsions contain the pigments and the pigment colors of instant claims 9-12, 14, 30, 48, 66, and 81.

Although the combined references above teach an emulsified organic pigmented composition, which may further contain inorganic pigments, the references lack the specific copolymers of instant claims 18-20, 38-40, 55-57, and 73-75.

Calello et al., teach Glossy transfer resistant cosmetic compositions which can be incorporated into water and oil emulsions comprising a polymer, a volatile solvent, a nonvolatile oil, a dry particulate matter, and water. The tertiary reference teaches the specific silicone acrylate copolymers of instant claims 20, 40, 57, and 75 as being the most preferred polymers. The reference teaches that compositions comprising the polymer are long lasting, have a high gloss and shine and do not easily transfer to clothing or utensils. See: col. 1, lines 45-68; col. 4, lines 22-26; col. 6, line 52 – col. 7, line 7; col. 8, lines 29-45; and abstract.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the modified the long wearing organic pigmented composition of Shah by forming a water and oil emulsion as taught by McDermott and adding the specific silicone acrylate copolymer of Calello et al. because of the reasonable expectation of obtaining an emulsified organic pigment containing composition that can have surface coated pigments, which could be added to any

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desired phase and could contain pigments of any desired color, with an improved long lasting adherence to the skin and having a high gloss and shine.

Although the combined references lack the viscosity of the emulsion as claimed, it is the examiner's position that it is well within the skill of those having ordinary skill in the art, to adjust the viscosity of an emulsion to arrive at a desired viscosity. The examiner is providing Cosmetics, Science and Technology, Emulsification, Chapter 42, (1957) by William C. Griffin as a teaching reference to demonstrate that those skilled in the art clearly recognize the viscosity of an emulsion as a property of an emulsion, which can easily be controlled. See: pages 998-1004.

Although the references lack the limitations of claims 30, 48, 66, 81, and the claims, which depend therefrom, where the claim limitations require the organic pigment and the inorganic pigment, if present, to either be solubilized in, or dispersed in, a particular phase of the composition, it is the examiner's position that the solubility or dispersibility of a pigment, depend of the hydrophobic or hydrophilic property of the pigment itself. The examiner is providing Cosmetics, Science and Technology; Color in Cosmetics, Chapter 44, (1957) by Samuel Zuckerman, as a teaching reference to demonstrate that those skilled in the art clearly recognize that the solubilization of the pigment depends upon the inherent solubility parameters of the pigment itself.

As taught by Zuckerman, all of the FD&C colors are soluble either in water or in oil. Moreover, Zuckerman teaches that inorganic pigments are available to the cosmetic chemist as water-soluble dyes, oil-soluble dyes, and insoluble pigments. Thus, it is the examiner's position that one having ordinary skill in the art would readily recognize that

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hydrophobic ingredients are soluble in other hydrophobic ingredients and conversely, hydrophilic ingredients are soluble in other hydrophilic ingredients.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clinton Ostrup whose telephone number is (571) 272-0582. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (571) 272-0584. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Clinton Ostrup
Examiner
Art Unit 1614


Frederick Krass
Primary Examiner
Art Unit 1614
